

Remarks

Applicant wishes to thank the Examiners for extending the courtesy of a personal interview with Applicant's representative, Christopher Kilner, on January 31, 2001. Claims 30 and 32 have been amended for clarity. New claims 40-49 have been added; no new matter has been added.

35 USC §112 Rejections

As explained in the interview of January 31, 2001, Applicant submits that the term "consumer's consumer account" is more definite than "consumer account" in that it specifies that the account associated with the consumer. In view of this, Applicant submits that the claims meet the requirements of 35 USC §112 and requests reconsideration.

35 USC §102 and §103 Rejections based on DeLapa et al.

As presented in the above-mentioned interview, DeLapa et al. produces paper coupons rather than *eliminating* them, and under traditional claim construction rules, DeLapa et al.'s coupon cannot read on the *separately claimed* limitations of an *identification means and a paper coupon*.

To additionally define Applicant's invention over DeLapa et al., the claims have been amended to include "at least one means separate from a checkout register for each consumer to enter unutilized coupon information from printed coupons in the consumer's possession" or "entering, at a location separate from a checkout register, unutilized coupon information from printed coupons in a consumer's possession." In view of this, Applicant submits that the claims meet the requirements of 35 USC §102 and §103 in view of DeLapa et al. and requests

reconsideration.

Possible Rejections based on Nichtberger et al.

During the interview of January 31, 2001, the Examiners indicated that Applicant's response should address the reasons that the present invention is allowable over Nichtberger et al.'s "PAPERLESS SYSTEM FOR DISTRIBUTING, REDEEMING AND CLEARING MERCHANDISE COUPONS," as presented orally by Applicant's representative.

Nichtberger et al. cannot anticipate the present claims under 35 USC §102 because of the inclusion in claim 30 of "wherein said at least one means for each consumer to enter unutilized coupon information from printed coupons is the only means provided for consumers to add unutilized coupon information into their consumer account" and the inclusion in claim 40 of "wherein consumers are limited to adding unutilized coupon information into their consumer account solely from printed coupons in their possession."

Additionally, Nichtberger et al. does not render the present claims obvious under 35 USC §103 because, *as a whole*, it teaches away from the present invention.

Although col. 29, lines 56-68 suggest the *addition* of a paper coupon scanner to the system of Nichtberger et al., the primary purpose of the Nichtberger et al. patent is to *distribute and redeem coupons electronically with a paperless system*. To accomplish this, customers make an electronic selection of coupons from a display. Therefore, **to eliminate the electronic selection of coupons by customers as a distribution means, as would be necessary to make an obviousness rejection, would destroy the primary purpose of the Nichtberger et al. patent** and make it unsatisfactory for electronic coupon distribution. Such a rejection is improper in accordance with M.P.E.P. 2141.02 for failing to consider the reference as a whole. It is also

improper in accordance with M.P.E.P. 2143.01 as lacking a suggestion or motivation to modify the reference since to do so would render Nichtberger et al. unsatisfactory for its intended purpose of electronic coupon distribution.

In view of this, Applicant submits that the claims meet the requirements of 35 USC §102 and §103 in view of Nichtberger et al.

Conclusion

For the above reasons, Applicant respectfully submits that the application is in condition for allowance with claims 30-49 and requests reconsideration of the application. If there remain any issues that may be disposed of via a telephonic interview, the Examiner is kindly invited to contact the undersigned at the local exchange given below.

Respectfully submitted,



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